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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,430	01/22/2004	John J. Borzym	TMA-105-B	5191

7590

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EXAMINER

RACHUBA, MAURINA T

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,430

Applicant(s)

BORZYM, JOHN J.

Examiner

M Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/22/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I in the reply filed on 23 July 2004 is acknowledged. The traversal is on the ground(s) that "the preamble of claim 8 limits the positively recited apparatus to use "in combination with a bladeless shear" i.e., the very same application which is positively recited in claim I. In addition, claim I recites the drive apparatus in "means plus function" terms and, according to 35 U.S.C. 112 paragraph 6, this recitation must be construed to cover the corresponding structure and equivalence thereof. Claim 8 simply recites one of the corresponding structures. Therefore, while there is a scope difference between claims 1-7 and claim 8, examination of one would necessarily cover all of the subject matter of the other and a decision in favor of allowability of claim I, for example, would necessitate a similar decision with respect to claim 8". This is not found persuasive because it has not been claimed that the means for driving the movable ram is the structure of claim 8. Claim 8 limits the structure for driving an eccentric wheel and not the movable ram.

2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 23 July 2004.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Davis, 4,471,678. '678 discloses a supported shear of the type in which axially adjacent and integral lengths of linear stock such as tubing are laterally displaced relative to one another along a shear plane at right angles to the longitudinal axis of said stock: non-driven ram means for receiving and holding said stock; driven ram means adjacent the non-driven ram means for receiving said stock; and means for alternately driving said moveable ram in opposite directions through an orbital path relative to the non-driven ram. Here, the non-driven ram means is the same as that disclosed by applicant: a stationary ram **38** is mounted on the base and has a circular die aperture the shape of which conforms closely to the external surface of the stock and the central axis of which is aligned with the longitudinal axis of the stock (column 4, lines 40-46). The driven ram means **13** is adjacent the non-driven ram means. '678 discloses means for alternately driving the movable ram in opposite directions through an orbital path relative to the non-driven means. Here, the means is wheel **16** that rotates variable length crank arm **18** to drive movable ram **13** in opposite

directions through an orbital path. The means for alternately driving the movable ram in opposite directions through an orbital path disclosed by '678 is a structural equivalent of the corresponding element disclosed in the specification. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed.Cir. 1990). That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification. Here, the disclosed element translates rotary motion of the pinion into orbital (rotary and linear) motion of the driven ram. The means disclosed by '678 translates the rotary motion of wheel **16** into orbital (rotary and linear) motion of the driven ram **13**. If applicant argues that the driving means disclosed by '678 does not anticipate the claimed invention, then the examiner's position will be that rack and pinion elements to provide linear motion are old and well known, and that one of ordinary skill would consider it obvious to have provided '678 with such structure to provide rotary motion.

Allowable Subject Matter

6. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose the ram fully surrounding and accommodating a drive wheel, the wheel being rotatably driven through a shaft supported on the machine base by a fixed support, the shaft carrying a pinion which meshes with the teeth of a vertical rack which is alternately driven in opposite directions

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by hydraulic cylinders which are part of a linear actuator assembly. The closest art of record, '687, discloses the use of a flywheel/crank assembly to orbit the ram. Mills, 3,759,127 discloses a cylinder driven ring gear that drives pinions to eccentrically rotate cutting blades to cut through tubular stock, but the translation of motion is rotary to rotary, and not linear to rotary.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other similar shearing devices are cited of record.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is 571-272-4493.

The examiner can normally be reached on Monday-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M Rachuba
Primary Examiner
Art Unit 3723

